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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,584	04/05/2001	Gerhard Albrecht	512425-2059	5913

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EXAMINER

EGWIM, KELECHI-CHIDI

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 07/16/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/827,584

Applicant(s)

ALBRECHT ET AL.

Examiner

Dr. Kelechi C. Egwim

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become "ABANDONED" (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 May 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 20-22 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-19 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's affirmation of the election with traverse of Group II, claims 10-19 and 23 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that there is no undue burden in examining all the claims. This is not found persuasive because the search required for Group III is not required for Group I or II and the search required for group I is not required for group II.

The requirement is still deemed proper and is therefore made FINAL.

2. This application contains claims 1-9,20-22 and 24 drawn to inventions nonelected with traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10-19 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for reasons cited in the previous action.

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5. As previously stated, no useful prior art search/determination was possible due to the general indefinite nature of the claim as indicated above.

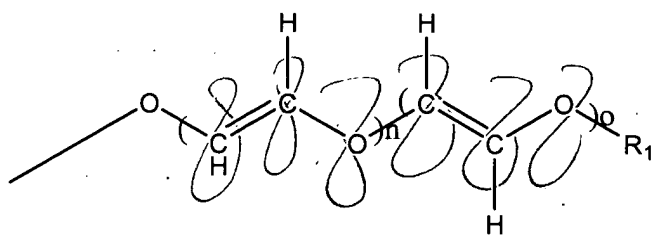
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**Response to Arguments**

6. Applicant's arguments filed 5/15/03 have been fully considered but they are not persuasive.

7. Regarding the variable "lm", while applicant does recite in the claims that "the index on the hydrogen atom [are] formed by the product of l and m", the recitation, in combination with the definition of "X" is inconsistent and one reasonably skilled in the art would still not recognize what applicant is intending to define.

If "lm" is the index of hydrogen atoms and is the product of "l" and "m", wherein l is 1 or 2, then according to this formula, if "l" is 1 and "m" is 2, then, according to the claims, X would have the structure:



, which is not an

oxyalkylenealkylglycol-alkylene ether moiety as recited.

The formula is still indefinite because it does not clearly define the structure of the ether moieties.

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8. Regarding the second issue of indefiniteness, firstly the recitation in applicant's arguments is not the same as the recitation in the claims (particularly claim 10).

Indentation becomes so critical when dealing with such complicated formulas and such a large variety of variables, particularly over multiple pages. Without keeping the indentation consistent, it becomes impossible to ascertain what definitions refer to what variables.

Within the definition of a particular variable, for instance "X", all the formulas or compounds representing "X" are to be put under the same level of indentation under "X". For instance:

X = Aabc,

B,

Cefg, or

D.

Any further variables further defining any of the formulas or compounds representing "X", are to be under another level of indentation under that particular formula or compound. For instance:

X = Aabc, wherein,

a = 1

b = 2

c = 3,

B,

Cefg, wherein,

$$e = 1$$

$$f = 2$$

$$g = 3, \text{ or}$$

---

D.

Otherwise it becomes unclear if the definitions are further definitions for X or definitions for a different variable. For Example:

$$X = Aabc,$$

$$a = 1$$

$$b = 2$$

$$c = 3,$$

B,

$$Cefg,$$

$$e = 1$$

$$f = 2$$

$$g = 3, \text{ or}$$

D.

For the reasons stated above and in the previous action, the claims are still indefinite and unsearchable. See MPEP § 608.01(m).

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

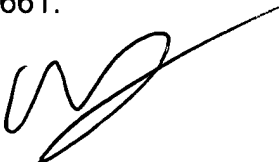
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.



KCE

July 14, 2003